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09/853,937	05/09/2001	Julien Tan Nguyen	139.1002.02	7225

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EXAMINER	
CHEA, PHILIP J	
ART UNIT	**PAPER NUMBER**
2153	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/853,937	NGUYEN, JULIEN TAN	
	Examiner	Art Unit	
	Philip J. Chea	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/23/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-8,25-29 and 41-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-8,25-29 and 41-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to an Amendment filed January 23, 2006. Claims 4-8,25-29,41-48 are currently pending, of which claims 45-48 are new. Any rejection not set forth below has been overcome by the current Amendment.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 45-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has added new claims 45-48 that have a limitation for automatically identifying a second one of said electronic mail messages for preloading or preloading the second electronic mail message for later presentation, without presentation of said first electronic mail message. The Examiner has found no support in the specification for allowing the system claimed to automatically identify a second one of said electronic mail messages for preloading. The Examiner invites the Applicant to point out specific portions of the specification that support this claimed feature.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4-8, 25-29, 41,43,45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Stratigos et al. and further in view of Judson et al (US 5,572,643).

As per claims 4, 25, 41, and 43, Brown discloses a system for presenting electronic mail messages to an operator, as claimed, including the steps of:

- loading a plurality of headers from a mail server, each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message (see page 369 Fig. 14.15, and page 370, paragraph 1);
- receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded (see page 370, *Opening and Replying to Messages*, where displaying the listings in the mailbox (Fig 14.15), and selecting a listing to open is considered a head prior to message being loaded);
- presenting said first electronic mail message to said operator (see page 370, *Opening and Replying to Messages*); and
- identifying a second one of said electronic mail messages for preloading (see page 369, Fig. 14.15, where a second message is identified as shown by the multiple messages in the summary window).

As to claim 25, it is similar to claim 4, 41 and 43 with the additional feature of:

- an input element coupled to said input port (see page 370, paragraph 1); and
- an output element coupled to said output port (see page 370, paragraph 1, where opening a window implies an output element),

Brown does not explicitly mention the feature of preloading said second electronic mail message for later presentation, without interrupting presentation of said first electronic mail message.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Brown, as evidenced by Stratigos et al.

In an analogous art, Stratigos et al. disclose a system for presenting electronic mail messages to an operator, including the steps of:

- preloading a second electronic mail message for later presentation, without interrupting presentation of a first electronic mail message (see column 6, lines 18-26).

Given the teaching of Stratigos et al., a person having an ordinary skill in the art would have obviously recognized the desirability and advantages of modifying Brown by preloading a second mail message without interrupting the first message, such as disclosed by Stratigos et al., in order to reduce the cost of transmission when accessing a series of documents (see Stratigos et al. column 2, lines 62-64).

Although the system disclosed by Brown in view of Stratigos shows substantial features of the claimed invention (discussed above), it fails to disclose presenting to said operator a status of said step of preloading said second electronic mail message.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Brown in view of Stratigos et al., as evidenced by Judson.

In an analogous art, Judson discloses presenting to an operator a status of preloading a second electronic message (see column 6, lines 35-39, where the inline message is shown as the hypertext document is being downloaded using the status bar from Fig. 5). The document in Fig. 5 is preloading as a user is shown a welcome screen shown in Fig 8.

Given the teaching of Judson, a person having an ordinary skill in the art would have obviously recognized the desirability and advantages of modifying Brown in view of Stratigos et al. by showing a status of a preloading message, such as disclosed by Judson, in order to let the user know when the preloading is done so they can proceed to view the preloaded message.

As per claims 45-48, Brown in view of Stratigos et al. and in view of Judson do not expressly disclose automatically identifying a second one of said electronic mail messages for preloading or preloading the second electronic mail message for later presentation, without interrupting presentation of

said first electronic mail message. However, at the time of the invention, making the identifying automatic would have been obvious to one of ordinary skill in the art. Please refer to *In re Venner*, 262 F.2d 91, 95, 120 USPQ 192, 194 (CCPA 1958).

As per claims 5 and 26, Brown in view of Stratigos et al. and in view of Judson further disclose displaying a partial preview of said second electronic mail message (see Judson Fig 5. where a downloading page shows a partial portion of the fully downloaded page [the status bar indicates and unfinished page]); and altering said partial preview in response to a change in status of said step of preloading said second electronic mail message (it is implied as the page continues to download, the partial preview will be altered to include the newly downloaded material).

As per claims 6 and 27, Brown in view of Stratigos et al. and in view of Judson further disclose displaying a preview of second electronic message in a distinct format (see Judson Fig 5. where a downloading page shows a partial portion of the fully downloaded page [the status bar indicates and unfinished page] HTML format).

As per claims 7 and 28 Brown in view of Stratigos et al. and in view of Judson further disclose that status includes the step of displaying at least one graphic element (see Judson Fig. 5, where the graphic element is considered the browser displaying in the bottom left corner the status amount of the page loading).

As per claims 8 and 29, Brown in view of Stratigos et al. and in view of Judson further disclose that status includes displaying text (see Judson Fig. 5. where a page loading indicates the status a percentage of completion).

5. Claims 42 and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Stratigos et al. and in view of Judson as applied to claims 41 and 43 above, and further in view of Jiang et al. Although the system disclosed by Brown in view of Stratigos et al. and in view of Judson shows substantial features of the claimed invention (discussed above), it fails to disclose an interrupt mechanism configured to interrupt the download mechanism, responsive to the first input mechanism.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Brown in view of Stratigos et al. and in view of Judson, as evidenced by Jiang et al..

In an analogous art, Jiang et al. disclose that it would have been obvious to have an interrupt mechanism configured to interrupt the download mechanism, responsive to the first input mechanism (see column 3, lines 7-21, where interrupting headers is analogous to interrupting the transmission of the first data frame when a user changes to a second frame before the first frame has been completely transferred).

Given the teaching of Jiang et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Brown in view of Stratigos et al. and in view of Judson by interrupting transmission of a first set of data when a second item is selected, such as disclosed by Jiang et al., in order to change the priority of data before it is completely transmitted (see Jiang et al. columns 2 and 3, lines 66-67 and 1-2).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 4 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,377,978 in view of Judson et al (US 5,572,643). Please see the claim mapping below where bold indicates the differences between the US Patent 6,377,978 and the instant application.

Patent US 6,377,978	Instant Application 09/853937
1. A method for presenting electronic mail messages to an operator, including the steps of loading a plurality of headers from a mail server, each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message;	1. A method for presenting electronic mail messages to an operator, including the steps of loading a plurality of headers from a mail server, each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message;
receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded;	receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded;
presenting said first electronic mail message to said operator;	presenting said first electronic mail message to said operator;
identifying a second one of said electronic mail messages for preloading; and preloading said electronic mail message for later presentation,	identifying a second one of said electronic mail messages for preloading; and preloading said second electronic mail message for later

without interrupting presentation of said first electronic mail message;	presentation, without interrupting presentation of said first electronic mail message; and
wherein said step of identifying said second electronic mail message for preloading is responsive to a preference designated by said operator.	**presenting to said operator a status of said step of preloading said second electronic mail message.**

Although the system disclosed by US Patent 6,377,978 shows substantial features of the claimed invention (discussed above), it fails to disclose **presenting to said operator a status of said step of preloading said electronic mail message**.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by U.S. Patent No. 6,377,978, as evidenced by Judson.

In an analogous art, Judson disclose presenting to an operator a status of preloading a second electronic message (see column 6, lines 35-39, where the inline message is shown as the hypertext document is being downloaded using the status bar from Fig. 5). In the preferred embodiment, the document in Fig. 5 is preloading as a user is shown a welcome screen shown in Fig 8 (see column 6, lines 12-24).

Given the teaching of Judson, a person having an ordinary skill in the art would have obviously recognized the desirability and advantages of modifying U.S. Patent No. 6,377,978 by showing a status of a preloading message, such as disclosed by Judson, in order to let the user know when the preloading is done so they can proceed to view the preloaded message.

Patent US 6,377,978	Instant Application 09/853937
1. A method for presenting electronic mail messages to an operator, including the steps of loading a plurality of headers from a mail server,	1. A method for presenting electronic mail messages to an operator, including the steps of loading a plurality of headers from a mail server,

each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message;	each one of said headers associated with an electronic mail message addressed to at least said operator, each of said plurality of headers loaded separately from its associated electronic mail message;
receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded;	receiving a dynamic selection of a first one of said electronic mail messages from said operator after at least one of said plurality of headers have been loaded and prior to said associated electronic mail message being loaded;
presenting said first electronic mail message to said operator;	presenting said first electronic mail message to said operator;
identifying a second one of said electronic mail messages for preloading; and preloading said electronic mail message for later presentation, without interrupting presentation of said first electronic mail message;	**automatically** identifying a second one of said electronic mail messages for preloading; and preloading said second electronic mail message for later presentation, without interrupting presentation of said first electronic mail message; and
wherein said step of identifying said second electronic mail message for preloading is responsive to a preference designated by said operator.	**presenting to said operator a status of said step of preloading said second electronic mail message.**

Although the system disclosed by US Patent 6,377,978 shows substantial features of the claimed invention (discussed above), it fails to disclose **automatically** identifying a second one of said electronic mail messages for preloading; and preloading said second electronic mail message for later presentation, without interrupting presentation of said first electronic mail message; and **presenting to said operator a status of said step of preloading said electronic mail message.**

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by U.S. Patent No. 6,377,978, as evidenced by Judson.

In an analogous art, Judson disclose presenting to an operator a status of preloading a second electronic message (see column 6, lines 35-39, where the inline message is shown as the hypertext document is being downloaded using the status bar from Fig. 5). In the preferred embodiment, the document in Fig. 5 is preloading as a user is shown a welcome screen shown in Fig 8 (see column 6, lines 12-24).

Given the teaching of Judson, a person having an ordinary skill in the art would have obviously recognized the desirability and advantages of modifying U.S. Patent No. 6,377,978 by showing a status of a preloading message, such as disclosed by Judson, in order to let the user know when the preloading is done so they can proceed to view the preloaded message.

In considering **automatically** identifying a second one of said electronic mail messages for preloading; and preloading said second electronic mail message for later presentation, without interrupting presentation of said first electronic mail message, at the time of the invention, making the identifying automatic would have been obvious to one of ordinary skill in the art. Please refer to *In re Venner*, 262 F.2d 91, 95, 120 USPQ 192, 194 (CCPA 1958).

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United Sates Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Response to Arguments

8. Applicant's arguments filed January 23 have been fully considered but they are not persuasive.

(A) Applicant contends that Judson does not disclose to said operator a status of said step of preloading said second electronic mail message.

(B) Applicant contends that decompressing an image file is not the same as preloading the image file.

In considering (A), the Examiner respectfully disagrees. The Examiner believes that the system of Judson would allow someone of ordinary skill in the art at the time of the invention to see that status bars are old and well known. Status bars allow users to recognize that a page has been fully loaded. Judson shows that the status of a page can be seen as it is loading and also allows a user to click on a link to see an object such as, an inline image, or another page while the other page is being loaded (see Fig. 3 [84]). So as an object is being displayed, the real page is currently being preloaded.

In considering (B), the Examiner respectfully disagrees. The Examiner invites the applicant to include specific language supported by the specification as to the difference of preloading and decompressing.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea
Examiner
Art Unit 2153

PJC 4/5/06

KRISNA LIM
PRIMARY EXAMINER